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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/851,848	05/09/2001	Andrew C. Gilbert	CF/033	3671
64558	7590	02/08/2007	EXAMINER	
FISH & NEAVE IP GROUP ROPES & GRAY LLP 1211 AVENUE OF THE AMERICAS NEW YORK, NY 10036-8704			AKINTOLA, OLABODE	
			ART UNIT	PAPER NUMBER
			3691	
SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE		
3 MONTHS	02/08/2007	PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/851,848	GILBERT ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Olabode Akintola	3691

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 19 December 2006.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-11, 19, 21, 22, 32, 34 and 35 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-11, 19, 21, 22, 32, 34 and 35 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date _____	6) <input type="checkbox"/> Other: _____

## **DETAILED ACTION**

This communication is in response to applicant's amendment filed on 12/19/2006. Claims 1-11, 19, 21-22 and 32-35 are pending. Claims 1, 19 and 32 have been amended. Claim 33 has been canceled.

### ***Claim Objections***

Claim 1 is objected to because of the following informalities: "cooling offer period" in line 6 of the claim should be "cooling off period". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 19 and 32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 19 and 32 recite, "receiving a request to cancel a first bid or offer for an item". However, the outcome of such request is not recited. It is not clear whether the request was successful or not, thereby making the claim in this present form indefinite.

Also, in the present form of the claim, the "time frame" of suspension of the order received during the cooling off period remains permanent (indefinite), i.e., the order is suspended indefinitely. This renders the claim indefinite.

Claims 9 and 10 recites the limitation "wherein suspending trading" in line 1. There is insufficient antecedent basis for this limitation in the claims.

All claims are broadly interpreted as best understood.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-11, 19, 21-22 and 32 are rejected under 35 U.S.C. 102(e) as being anticipated by Alaia et al. (U. S. Patent No. 6230147).

Re claims 1-11, 19, 21-22 and 32-33: Alaia teaches a method comprising: receiving a first bid or offer to trade an item; receiving a second bid or offer to trade the item, the first and second bids or offers each submitted by a trader and each specifying a price (col. 26, lines 35-55); receiving a request to cancel the first bid or offer (col. 26, lines 1-16); determining a difference between the price of the first bid or offer and the price of the second bid or offer (col. 10, lines 24-29); starting a cooling off period timer when the difference between the price of the first bid or offer and the price of the second bid or offer is greater than a predetermined amount (col. 14, lines 1-40); receiving from the buyer or seller, during the cooling off period, an order to buy or sell the item; suspending the order to buy or sell the item for the buyer or seller to notice a change in the

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first bid or offer and the second bid or offer prices (col. 10, lines 24-29); wherein suspending trading further comprising setting a cooling off period (Abstract; col. 18, lines 1-15); allowing the second trader to respond to the second bid or offer upon completion of the cooling off period (col. 18, lines 1-15).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 34-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alaia as applied in claim 1 above, and further in view of Applicant's own admitted prior art (see the specification, page 2, lines 7-30).

Re claims 34-35: Alaia does not explicitly teach the step wherein at least one of the first and the second bids or offers are submitted during a period wherein the trader has exclusivity; wherein at least one of the first and the second bids or offers are submitted during a period wherein the

trader cannot cancel bids or offers. Applicant's admitted prior art teaches these steps (page 2, lines 7-30). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Alaia to include these steps as taught by Applicant's own admitted prior art. One would have been motivated to do so in order to afford the bidder the right of first refusal to a trade at certain level. Also, in order to give other bidders an opportunity to respond to the bids and offers before they can be cancelled by the bidders that submitted them.

***Response to Arguments***

In response to applicant's argument that Alaia fails to teach the limitation "starting a cooling off period timer when the difference between the price of the first bid or offer and the price of the second bid or offer is greater than a predetermined amount; receiving from the buyer or seller, during the cooling off period, an order to buy or sell the item; suspending the order to buy or sell the item for the buyer or seller to notice a change in the first bid or offer and the second bid or offer prices". Examiner disagrees. Examiner interprets col. 14, lines 1-40, as reading on this feature (starting a timer in response to price difference).

*Conclusion*

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olabode Akintola whose telephone number is 571-272-3629. The examiner can normally be reached on M-F 8:30AM -5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

OA



HANI M. KAZIMI  
PRIMARY EXAMINER